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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,312	02/24/2004	Todd L. DePue	MASL-29	2311
37690 7590 03/23/2007 WOOD, HERRON & EVANS, LLP (LEAR) 2700 CAREW TOWER 441 VINE STREET CINCINNATI, OH 45202			EXAMINER LAMBELET, LAWRENCE EMILE	
			ART UNIT	PAPER NUMBER
			1732	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/23/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/708,312

Applicant(s)

DEPUE, TODD L.

Examiner

Lawrence Lambelet

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 5 and 7-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5 and 7-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

Applicant's amendment filed on 12/20/2006 is acknowledged. Cancelled claim 6 and amended claim 5 are placed of record in the file. Claims 5 and 7-9 are pending.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bertschi et al (U.S. Patent 5,651,998) in view of Thompson (U.S. Patent 6627134), and further in view of Dry (U.S. Patent 6,899,363).

Bertschi et al, hereafter "Bertschi", discloses a method of forming a multi-layered molded article, as recited by claim 5. Bertschi teaches injecting three materials into a mold using a combination of co-injection and singular-injection nozzles. See lines 28-62 in column 7 and Fig. 16. Bertschi further teaches that the injections can be independently effected and that the co-injection nozzle is capable of simultaneous injection, as shown at lines 57-61 in column 7. Accordingly, and with reference to Fig. 16, it can be seen that a first material, reference character 492, representing a first shot,

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is the substrate member, and that second and third materials, 444 and 490, simultaneously co-injected in a second shot, represent a cover member on the substrate.

Bertschi does not teach that second and third materials are outer pliable and inner compressible layers formed during a co-injection step, as required by claim 5.

Thompson teaches forming a skin material over a core material in a co-injection process at lines 63-67 in column 2 and lines 1-6 in column 3. Thompson further teaches that the skin material is Santoprene (pliable) in example 4. Thompson still further teaches that the core is a foam material (compressible layer) at lines 35-40 in column 1.

Bertschi and Thomson are combinable because they are concerned with a similar technical field, namely, multi-shot molding. One of ordinary skill in the art at the time of the invention would have found it obvious to include the skin/foam combination taught by Thomson in the multi-layered molded article method of Bertschi. The motivation to do so would have been to use low cost recycled material where it is not visible. See lines 35-43 in column 1 of Thomson.

Bertschi/Thomson does not teach a substrate member forming an automotive armrest, as required by claim 5.

Dry teaches the construction of an automotive armrest with a flexible foam or elastomeric pad for a cushion material sandwiched between a substrate and a cover layer. See lines 15-20 in column 1.

Bertschi/Thomson and Dry are combinable because they are concerned with a similar technical field, namely, multi-shot molding. One of ordinary skill in the art at the time of the invention would have found it obvious to include the automotive application and cushion material taught by Dry in the multi-layered molded article method of Bertschi/Thomson. The motivation to do so would have been to achieve an aesthetically and tactilely pleasing surface. See lines 63-68 in column 2 of Dry.

Claims 5 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schoemann et al (U.S. Patent Application Publication 2004/0017023), and further in view of Thompson..

Schoemann et al, hereafter "Schoemann", discloses two-shot molding process for an interior door trim panel, as required by claim 5. Schoemann teaches that a substrate is formed of a first material in a mold having a two-shot capability provided by a movable core forming a recess in the substrate. This is shown in paragraphs [0029] and [0030]. Schoemann further teaches that a second material forming an accent region (cover) is injected in the recess in a second shot after the mold is reconfigured. See paragraphs [0034] and [0035] and Fig. 1.

Schoemann teaches that the first material is polypropylene, which is a thermoplastic olefin, as required by claim 7. See paragraph [0032].

Schoemann does not teach co-injecting a third material, as required by claim 5. Schoemann further does not teach that second and third materials are outer pliable and inner compressible layers formed during a co-injection step, as also required by claim 5.

Schoemann still further does not teach that the second material is a thermoplastic elastomer, as required by claim 8.

Thompson teaches forming a skin material over a core material in a co-injection process at lines 63-67 in column 2 and lines 1-6 in column 3. Thompson further teaches that the skin material is Santoprene (thermoplastic elastomer) in example 4. Thompson still further teaches that the core is a foam material (compressible layer) at lines 35-40 in column 1.

Schoemann and Thomson are combinable because they are concerned with a similar technical field, namely, molding multilayered articles. One of ordinary skill in the art at the time of the invention would have found it obvious to include in the method of Schoemann a cushion-like panel insert, as taught by Thomson. The motivation, as taught by Schoemann in paragraph [0034], is to provide a tactilely pleasing surface. A surface which is yielding as well as soft, as taught by Thomson, advances that purpose.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schoemann in view of Thomson as applied to claims 5 and 7-8 above, and further in view of Dry.

Schoemann/Thomson teach the method of claims 5-8, as discussed above.

Schoemann/Thomson do not teach the third material as a thermoplastic elastomer foam, as required by claim 9.

Dry teaches a flexible foam or elastomeric pad for a cushion material sandwiched between a substrate and a cover layer. See lines 15-20 in column 1.

Schoemann/Thomson and Dry are combinable because they are concerned with a similar technical field, namely, molding multilayered articles. One of ordinary skill in the art at the time of the invention would have found it obvious to include in the method of Schoemann/Thompson the cushion construction of Dry. The motivation, as taught by Schoemann in paragraph [0034], is to provide a tactilely pleasing surface. The cushioning material, as taught by Dry, further advances that purpose.

### ***Response to Arguments***

Applicant's arguments with respect to claim 5 have been considered but are moot in view of the new ground(s) of rejection.

With regard to Bertschi, applicant argues that the reference fails to teach or suggest an automotive application, and further, fails to teach or suggest a cover member on a substrate with outer pliable and inner compressible layers. In response, the combination with Dry teaches an automotive armrest application, and the combination with Thomson teaches the pliable/compressible features in a three-material co-injection process.

With regard to Shoemann in view of Thomson, applicant argues that the references fail to teach or suggest an assembly using three materials. Applicant further argues that there is no teaching to combine. In response, Shoemann teaches adding a tactile element to an automotive interior door trim panel in a multi-shot process. Thomson teaches a skin over foam composite, having obvious implications for a tactile feature, in a co-injection process. The combination shows a three-material, multi-shot,

solution to a problem of forming a feature on a substrate with reasonable expectation of success. The motivating teaching for the tactile feature is found at paragraph [0034] in Shoemann, as discussed above.

With regard to Shoemann/Thomson in view of Dry, applicant argues that Dry fails to teach or suggest a third material and does not teach or suggest co-injecting a foam material. In response, Dry contributes the flexible foam component. The Shoemann/Thomson combination teaches the third material and the co-injection method. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Examiner disagrees that that the prior art assemblage was solely a matter of hindsight. There are themes of tactile feature and multi-shot molding throughout the reference combinations presented. With regard to improper hindsight, "any judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper." *In re McLaughlin*, 443 F. 2d 1392, 1395 USPQ 209, 212 (CCPA 1971).



***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Lambelet whose telephone number is 571-272-1713. The examiner can normally be reached on 8 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on 571-272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LEL  
3/16/2007

  
CHRISTINA JOHNSON  
SUPERVISORY PATENT EXAMINER